

**REMARKS**

This paper is being filed in response to the Advisory Action dated May 1, 2003 and the Office Action dated September 10, 2002 that were issued in connection with the above-identified patent application. Applicants respectfully request continued examination of the instant application pursuant to 35 U.S.C. §132(a) and 37 C.F.R. §1.114(a)(2) and enclose herewith the fee required pursuant to 37 C.F.R. §1.17(e). Applicants also enclose herewith a Petition for Extension of Time pursuant to 37 C.F.R. §1.136(a) and the fee required under 37 C.F.R. §1.17(a)(1). Applicants respectfully request reconsideration of the instant application in view of the amendments and remarks presented herein.

Applicants filed an Amendment on December 9, 2002. According to the Advisory Action dated May 1, 2003, this Amendment has not been entered. Applicants respectfully request entry and consideration of the amendments and remarks presented in that Amendment.

Claims 1, 3, 6-11, and 15-17 will be pending upon entry of Applicant's December 9, 2002 amendment. New claim 18 has been added by the instant amendment. New claim 18 is supported by the application as originally filed, *inter alia*, at page 2, lines 3-4 and, therefore, does not constitute new matter. No claims have been amended by the present amendment. Therefore, claims 1, 3, 6-11, and 15-18 will be pending upon entry of the instant Amendment.

New claim 18 appears in the preceding "IN THE CLAIMS" section. Attached hereto is a clean version of the pending claims. The attached pages are captioned "CLEAN VERSION FOR EXAMINER'S CONVENIENCE." Should any discrepancies be discovered, the version presented previously (most recent; claims 1, 3, 6-11, and 15-17) or in the preceding "IN THE CLAIMS" section herein (claim 18) shall take precedence.

Claim 1 stands rejected under 35 U.S.C. §102(B) as allegedly anticipated by Accession No. AA398583 of Hillier et al. (hereinafter "Hillier"). The Examiner has acknowledged that Hillier is silent regarding a nucleotide sequence that encodes a lysozyme, but alleges that such property is inherent. Claims 6-11 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent 5,643,758 to Guan et al. (hereinafter "Guan") in view of Hillier.

Applicants traverse these rejections for the reasons set forth in Applicants December 9, 2002 Amendment. Applicants further assert that Hillier fails to teach or suggest a nucleic acid that encodes a functional lysozyme protein. The Examiner has asserted that Hillier would inherently have the property of encoding the claimed lysozyme. Applicants respectfully disagree and invite the Examiner's attention to MPEP §2112 which states that it is not enough that "a certain result or characteristic may occur or be present" in the cited document (emphasis in original). Rather, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the cited document. MPEP §2112, *citing Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original).

Neither the Office Action dated September 10, 2002 nor the Advisory Action dated May 1, 2003 provides the required reasonable support. Specifically, the Examiner has not provided any support for the assertion that the **length** and **reading frame** provided by the instant claimed invention necessarily flow from the disclosure of Hillier. Therefore, Applicants assert that the Examiner has not satisfied the burden imposed by MPEP §2112. Absent some teaching or suggestion of a length and reading frame, Hillier, does **not necessarily** result in a gene product that has lysozyme activity. Moreover, Applicants respectfully observe that raw DNA

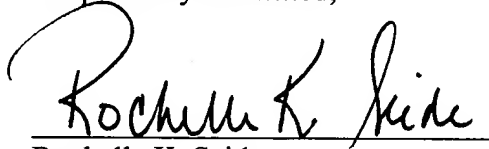
sequence data is unpatentable and of little real world use. In addition, mining raw DNA sequence for useful genes and gene products is far from simple or routine, but rather constitutes a major research undertaking by numerous academic and commercial inventors. Thus, the length, reading frame, and function of the reverse complement of nucleotides 152 to 535 of Hillier, even if shown to be necessarily present, would not be recognized as such by persons of ordinary skill in the art in the absence of Applicant's disclosure. See MPEP §2112, *citing In re Robertson*, 169 F.3d 743, 745, 49, U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.")(internal quotes omitted).

Notwithstanding the foregoing arguments, in view of the Examiner's statement in the Advisory Action that a claim that recites a lysozyme that consists of amino acids 19-146 of SEQ ID NO:4 may overcome the rejection under §102(b), Applicants respectfully invite the Examiner's attention to claim 18.

Therefore, Applicants believe that claims 1, 3, 6-11, and 15-18 are in condition for allowance and respectfully request timely issuance of a Notice of Allowance.

Applicants enclose herewith the fee required under 37 C.F.R. §§ 1.16(b), 1.17(a)(1), and 1.17(e). Applicants do not believe that any additional fees are required with this paper. Nevertheless, the Commissioner is hereby authorized to charge any fees occasioned by this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Please credit any overpayment of fees associated with this filing to the above-identified deposit account. A duplicate of this page is enclosed.

Respectfully submitted,



Rochelle K. Seide  
PTO Reg. No. 32,300  
Attorney for Applicants

Guy F. Birkenmeier  
PTO Reg. No. 52,622  
Agent for Applicants

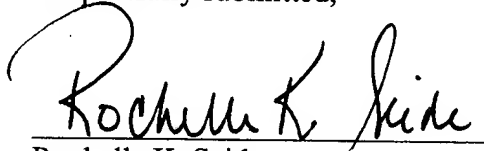
BAKER BOTTS, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-2500

June 9, 2003

Enclosure

Applicants enclose herewith the fee required under 37 C.F.R. §§ 1.16(b), 1.17(a)(1), and 1.17(e). Applicants do not believe that any additional fees are required with this paper. Nevertheless, the Commissioner is hereby authorized to charge any fees occasioned by this submission not otherwise enclosed herewith to Deposit Account No. 02-4377. Please credit any overpayment of fees associated with this filing to the above-identified deposit account. A duplicate of this page is enclosed.

Respectfully submitted,



Rochelle K. Seide  
PTO Reg. No. 32,300  
Attorney for Applicants

Guy F. Birkenmeier  
PTO Reg. No. 52,622  
Agent for Applicants

BAKER BOTTS, L.L.P.  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-2500

June 9, 2003

Enclosure